

ESTTA Tracking number: **ESTTA456781**

Filing date: **02/15/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Sazerac Company, Inc.
Granted to Date of previous extension	02/15/2012
Address	3850 N. Causeway Blvd., Suite 1695 Metairie, LA 70002 UNITED STATES

Attorney information	Heather Dunn Navarro Cooley LLP 777 6th Street, Suite 1100 Washington, DC 20001 UNITED STATES trademarks@cooley.com, hdnavaarro@cooley.com Phone:650-843-5000
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### Applicant Information

Application No	85371749	Publication date	10/18/2011
Opposition Filing Date	02/15/2012	Opposition Period Ends	02/15/2012
Applicant	Department 28, Inc 1302 S. PARKSIDE DRIVE PALATINE, IL 60067 UNITED STATES		

### Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: Vodka
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	852889	Application Date	08/30/1967
Registration Date	07/16/1968	Foreign Priority Date	NONE
Word Mark	TRAVELERS CLUB		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 033. First use: First Use: 1964/06/10 First Use In Commerce: 1964/06/10 WHISKEY
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U.S. Application No.	85413234	Application Date	09/01/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TRAVELERS CLUB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2010/04/00 First Use In Commerce: 2010/04/00 gin and vodka		

Attachments	85413234#TMSN.jpeg ( 1 page )( bytes ) NOO - TRAVELLER BLACK EDITION VODKA.pdf ( 5 pages )(48592 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/hdn/
Name	Heather Dunn Navarro
Date	02/15/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial No. 85/371,749  
For the Trademark TRAVELLER BLACK EDITION VODKA

SAZERAC COMPANY, INC.,	)	
	)	
Opposer,	)	
	)	Opposition No.
v.	)	
	)	
DEPARTMENT 28, INC.,	)	
	)	
Applicant.	)	
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**NOTICE OF OPPOSITION**

Opposer Sazerac Company, Inc. (“Sazerac”), a Louisiana corporation having its principal place of business at 3850 N. Causeway Boulevard, Suite 1695, Metairie, Louisiana 70002, will be damaged by the issuance of a registration for the mark TRAVELLER BLACK EDITION VODKA (“Applicant’s Mark”), as applied for in Application Serial No. 85/371,749 filed on July 14, 2011 by Applicant Department 28, Inc., an Illinois corporation having its principle place of business at 1302 S. Parkside Drive, Palatine, IL 60067 (“Applicant”). Sazerac, having previously been granted an extension of time to oppose Applicant’s Mark, hereby opposes same.

As grounds for opposition, Sazerac alleges:

1. Sazerac and its subsidiaries market and sell a number of different types and brands of alcoholic beverages and distilled spirits, including whiskey, vodka, gin, liqueurs, tequila, and wine. Sazerac has marketed and sold alcoholic beverages and distilled spirits in the United States for over a century.

2. Sazerac and its wholly-owned subsidiary, Majestic Distilling Company, Inc. (“Majestic”), own the following trademark registration and application in the United States:

TRAVELERS CLUB, U.S. Reg. No. 0852889, issued July 16, 1968 for “whiskey”; and

TRAVELERS CLUB, U.S. Serial No. 85/413,324, filed September 1, 2011 for “alcoholic beverages; namely, vodka and gin.”

3. Sazerac and Majestic have consistently and continually marketed and sold distilled spirits under the TRAVELERS CLUB marks since at least as early as June 10, 1964. By virtue of their efforts and by virtue of the excellence of their products, the public has come to know, rely on, and recognize the mark TRAVELERS CLUB as a source identifier for Sazerac’s vodka, gin and whiskey products. Sazerac has gained valuable reputation and goodwill through the use and recognition of its TRAVELERS CLUB marks over the past 47 years.

4. Upon information and belief, Sazerac alleges that on July 14, 2011 Applicant filed an Application to register the mark TRAVELLER BLACK EDITION VODKA on intent to use basis (Section 1(b)). Applicant seeks registration in connection with alcoholic goods, specifically, “vodka.”

5. Applicant’s Mark is likely to be confused with and mistaken for Sazerac’s TRAVELERS CLUB marks because both marks share the first and dominant mark component “TRAVELER”; Applicant simply utilizes the singular form and an alternate spelling of the TRAVELER mark component (“TRAVELLER”). The “BLACK EDITION” mark component of Applicant’s Mark describes the dominant color of the packaging, and its “VODKA” component is merely descriptive of the product itself. Thus, Applicant’s Mark is nearly identical to Sazerac’s TRAVELERS CLUB in sight and sound and is identical in meaning and

commercial connotation.

6. If Applicants' Mark is allowed to register, a likelihood of confusion will be created for consumers of alcoholic beverages. Applicants' Mark is intended for use in connection with products that are identical to and overlap with Sazerac's TRAVELERS CLUB products, and that are related to and directly overlap with other Sazerac products.

7. Applicants' targeted customer base is identical to the consumers of Sazerac's products marketed and sold under the TRAVELERS CLUB Mark and directly overlaps with the consumers of Sazerac's other alcoholic beverages and distilled spirits products, including vodkas, gins, and whiskeys.

8. As Applicant's goods description contains no restrictions or limitations as to channels of trade, Sazerac may assume that Applicant's mark, like Sazerac's own TRAVELERS CLUB Marks, will be used and displayed in all accepted channels of trade. Therefore, in addition to overlapping consumer bases, Applicant's channels of trade for its alcoholic beverages overlap with the channels of trade used by Sazerac in marketing, selling, and otherwise distributing its TRAVELERS CLUB vodka, gin, and whiskey.

9. If Applicant is permitted to register Applicant's Mark for the goods specified in the Application herein opposed, confusion resulting in damage and injury to Sazerac would likely occur. Consumers familiar with Sazerac's marks would likely perceive Applicant's alcoholic beverages as associated or affiliated with or sponsored by Sazerac. Such confusion would inevitably result in damage to Sazerac.

10. Customers of Sazerac's products and the relevant public are likely to misapprehend Applicant's Mark as a Sazerac mark rather than a Department 28, Inc. mark and/or believe in error that alcoholic beverages offered under the TRAVELLER BLACK EDITION VODKA

Mark are offered by or in association with or under license from Sazerac.


11. Any defect, objection to, or fault found with Applicant's goods marketed under the TRAVELLER BLACK EDITION VODKA Mark would necessarily reflect on and injure the reputation that Sazerac has established for its alcoholic beverages and distilled spirits products.

12. Registration of Applicant's Mark would give Applicant *prima facie* evidence of the validity and ownership of Applicant's Mark and of Applicant's exclusive right to use Applicant's Mark, all to the detriment of Sazerac.

13. Wherefore, Sazerac prays that this Opposition be sustained and that Application Serial No. 85/371,749 be denied and refused registration.

COOLEY LLP

Date: February 15, 2012

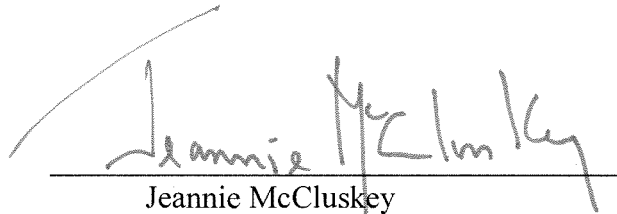
By:   
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## CERTIFICATE OF SERVICE

I hereby certify that on February 15, 2012, I mailed the foregoing NOTICE OF OPPOSITION regarding Sazerac Company, Inc. v. Department 28, Inc. to Counsel for Applicant by depositing a true and correct copy of the same with the United States Postal Service, first class mail, postage prepaid, in an envelope addressed to:

Christopher Ditico  
Raj Abhyanker  
Raj Abhyanker, P.C.  
1580 W. El Camino Real, Suite 8  
Mountain View, CA 94040-2462

Date: February 15, 2012



Jeannie McCluskey